

REMARKS

Favorable reconsideration of this application, in view of the foregoing amendments and following remarks, is respectfully requested.

Referring to the various sections of the Action in the order referred to therein:

Claim Objections

Amendments have been made to claims 1-26, now canceled and replaced by nineteen claims, namely claims 27-45, that are believed to overcome the Examiner's objection to original claims 4-24, as being in improper form, by eliminating any and all multiple dependent claims. Accordingly, claims 27-45 are believed to be in proper form for examination and allowance.

Claim Rejections – 35 U.S.C. §102

Original claims 1,3, 25 and 26 have been canceled and replaced by new claims 27, 30 and 45. New claim 28 is directed to the subject matter shown in FIG. 1A and described on page 14, third paragraph, lines 11-16 . The nineteen new claims 27-45 correspond respectively to certain of the thirty-six canceled claims 1-26 as set forth in the following claim number correspondence chart.

Claim # Correspondence Chart

<u>Order #</u>	<u>New Claim #</u>	<u>Old Claim #</u>
1.	27	1
2.	28	New FIG. 1A
3.	29	8
4.	30	3
5.	31	4
6.	32	9
7.	33	11
8.	34	12
9.	35	13
10.	36	14
11.	37	15
12.	38	16
13.	39	17
14.	40	18
15.	41	19
16.	42	20
17.	43	21
18.	44	22
19.	45	25

To further assist the Examiner, note that the amendments to canceled claims 1-26 now embodied in new claims 27-45 are set forth in the enclosed WORD TRACKING document received in hard copy from our German associate (utilizing original claim numbering).

Claims 27-29, 44, and 45 as amended clearly define novel structure over the cited Branch et al. U.S. Patent 6,335,869 cited and relied upon by the

Examiner as the sole reference in support of the §102 anticipation rejection. The Examiner is of the opinion that Branch includes ESD protection means utilizing the electromagnetic radiation shield 120. However the Examiner admits that Branch does not so state. The Examiner thus is necessarily resorting to the doctrine of inherency to support his § 102 rejection. But Branch cannot inherently anticipate because member 120 in Branch is an electromagnetic radiation grounding shield that cannot act as an ESD protection means as claimed.

An ESD protection means is one which protects against Electro-Static Discharges (ESD), particularly against ESD from charged objects that might enter the connector receptacle. Such ESD protection means is not provided by any of the electromagnetic radiation shielding disclosed in Branch.

In Branch, the end 124 of shield 120 is formed with a plurality of tabs 134 and 136 (column 7, lines 55-64). Tab 136 is an appendage between the tabs 134 and is long enough to engage the interior surface of shield 100 and thus provides "a redundant electrical connection between shield 100 and shield 120" (column 8, lines 6-8). Tab 136 may be further provided with a punched and projecting sub-tab 140 which makes contact with the plastic chassis 20 (see FIGS. 3 and 7 combined) and thereby serves to prevent the shield 120 from deforming when shield 100 deflects and compresses appendage 136 (column 8, lines 24-29). The chassis 20 is generally a parallelepiped shaped structure with an end forming duplex receptacles 32 which are separated by a partition wall (not referenced).

Neither tab 136, nor sub-tab 140, of the shield 120 that makes contact with the chassis 20, are exposed to contact with fingers of a person or any charged object that might enter into the receptacle of the connector. Please note that the duplex receptacle 32 (FIG. 2 of Branch) is arranged in the space in front of the projecting tab 140. Branch shows in FIG. 4 a partition wall (not referenced) covering the tab 136 and preventing any finger access to the tab 136; likewise for charged objects. Thus, the shield 120 is not an ESD protection means, either expressly or by inherency.

35 U.S.C. § 102

It is axiomatic that, in order to “anticipate” a claim, “all the elements in the claim (or possibly their equivalents...) must have been disclosed in a single prior art reference or device.” *Radio Steel & Mfg. Co. v. MTD Products, Inc.*, 731 F.2d 840, 845, 221 U.S.P.Q. 657, 661 (Fed. Cir. 1984). Moreover, “it is incumbent upon the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (BPAI 1990). It is respectfully submitted that Branch ‘869 does not disclose or suggest all the elements of claims 27-45, nor has the Examiner identified wherein Branch ‘869 allegedly teaches “each and every facet” of the invention even as initially claimed in claims 1-26.

As further set forth in M.P.E.P. § 2131 (pgs. 2100-69, Rev. 5, Aug. 2006).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The

elements must be arranged as required by the claim, but this is not an *Ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

As further pointed out in M.P.E.P. § 706.02 (pgs 700-10).

The distinction between rejection based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. In other words, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Whereas, in a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The modification must be one, which would have been obvious to one of ordinary skill in the art at the time the invention was made."

In view of the foregoing, the Examiner's reliance on Branch '869 must be relegated to that of an implicit reliance solely on a drawing disclosure, which again in fact is improper. However, again, nowhere in the '869 patent is there any statement or description that any of the FIGS. 1 through 8 are drawn to scale. Reliance solely on the drawing of the '869 patent again is clearly improper because it also would be an error in law due to lack of recognition of the problem to which applicant's invention is directed, much less applicant's solution, and again for the reasons more fully set forth in the discussion regarding reliance on drawing disclosures set forth hereinafter.

Reliance on Drawing Disclosures of the Cited Patent References Improper in Fact and Law

The Examiner undoubtedly will appreciate from the foregoing that the problem to which the present invention is directed is not disclosed by the description and/or claims of the cited '869 patent reference. Moreover, the drawings in the cited

'869 patent, which is all the Examiner apparently implicitly relies upon for his § 102 rejection, simply do not teach or suggest applicant's claimed invention, nor could they, to those skilled in the art who had never seen applicant's disclosure. The cited patent drawings occur in a reference that in no way is directed toward the ESD problem to which the applicant's invention is directed. Therefore these patent drawings must be viewed as a teaching vacuum insofar as applicant's invention as claimed is concerned. Although a drawing is available as a reference for all that it teaches a person of ordinary skill in the art, the drawings in the cited '869 patent reference are clearly of no avail in anticipating or rendering applicant's invention obvious as claimed.

Moreover, it is improper under the applicable statutory and case law for the Examiner even to attempt to rely on the drawing disclosure of the cited '869 patent for a teaching relevant to applicant's disclosure and claims. First of all, nowhere in this patent does it state the figures in the drawings are drawn to scale. Absent any written description in the specification of this patent of applicant's claimed structure and structural relationships and related parameters, much less ESD configurations, a rejection based on guesses as to the inherent functioning of what is shown in these drawing figures is clearly improper. *In re Chitayat*, 56 CCPA 1343, 161 U.S.P.Q. 224 (1969).

With respect to the rejection of claim 1 as being obvious, implicitly, in view of the drawings of the cited '869 patent reference, the Examiner's attention is also respectfully directed to the case of *In re Meng and Driessen*, 181 U.S.P.Q. 94 (CCPA 1974). In *Meng*, the application claims were directed to a package and a method for

producing a package containing a stack of individual flexible product slices wherein the lateral edges of adjacent slices were offset relative to one another to provide gripping portion for easy separation. The Examiner rejected these claims as being obvious in view of "Beck" patent, which appeared to show in one drawing (FIG. 10) packaged product slices having offset edges but did not discuss such edges, in view of "Palmer" which disclosed a method for packaging sliced products. The Board of Appeals affirmed this rejection.

Reversing the Board, the CCPA at 96 stated:

The issue to be decided is, "Would one of ordinary skill in the art, presented with that problem and [the reference] – and totally unaware of appellants' solution – be led to do what appellants did?" We think not.

Continuing at 97, the Court said:

But "whether one would recognize the solution to the aforementioned problem" [in the reference] *is* controlling. It begs the question to say that the claimed package is "illustrated by FIG. 10." A claimed invention is "illustrated," in the sense of 35 U.S.C. 103, by a drawing which, independently of an applicant's disclosure, would lead those skilled in the art to recognize the claimed invention as the solution to the problem it solved, i.e., by a drawing which renders the invention "obvious."
In our view, the claimed package is not illustrated in FIG. 10. . .

* * *

We are aware, of course, that a claimed invention may be anticipated or rendered obvious by a drawing in a reference, whether the drawing disclosure be accidental or intentional. [citation omitted] But, as the solicitor correctly states, a drawing is available as a reference *for all that it teaches* a person of ordinary skill in the art. The drawing here, FIG. 10 of Beck, simply would not, in our view, teach or suggest the claimed invention to those who had never seen appellants' disclosure. * * * We are further stayed from

a holding of obviousness when, as here, the drawing occurs in a reference in no way directed toward the problem involved, and the drawing must be viewed in a teaching vacuum so far as the invention before us is concerned.

As we said in [citation omitted], references must be evaluated by ascertaining the facts fairly disclosed therein as a whole. So evaluated, the Beck reference does not render the product claims before as obvious. (emphasis in text)

To paraphrase the Court in *Meng*, it is respectfully submitted that the invention claimed in the present application is not "illustrated" in the sense of 35 U.S.C. §102 or §103 by the drawings in the cited '869 patent reference since such drawings do not "lead those skilled in the art to recognize the claimed invention as the solution to the problem it solved." These reference patent drawings occur in a reference which is not directed to the problems sought to be solved, and these drawings must be viewed in a vacuum insofar as the present invention is concerned. Evaluating the cited '869 reference patents for the facts "fairly disclosed therein as a whole," it is submitted that the '869 reference patent does not render the present invention anticipated under 35 U.S.C. § 102 nor obvious under 35 U.S.C. § 103.

It will be appreciated of course that the foregoing discussion of the cited Branch '869 patent reference as initially applied to original claim 1 (now claim 27 as amended) is equally applicable, if not more so, to the remaining claims 28-45 as now presented.

New claim 28 is directed to the matter shown in FIG. 1A and disclosed on page 14, paragraph 3 of the specification. No corresponding structure is shown or disclosed in the cited Branch et al. '869 patent.

New claims 29 through 45 correspond to various ones of the original claims 4-23 (as set forth in the foregoing claim correspondence chart) that were not treated on their merits in the first Office Action (per the first paragraph on page 2 of the Action). However, claims 29-45 are now in proper form (no multiple dependency), and claims 29-45 are directly or successively dependent on claim 1 discussed hereinabove. Hence, claims 29-45 are neither anticipated under 35 U.S.C. §102 nor obvious under 35 U.S.C. § 103 for at least the same reasons as pointed out hereinabove. Additionally, it is believed to be evident that claims 29-45 individually call for additional novel features not shown, described or suggested by Branch et al. '869.

In view of the foregoing, all of the claims 27-45 now present in this application clearly define novel structure over Branch et al. '869 under 35 U.S.C. §102(b).

Moreover, in view of the novel and non-obvious structure and function set forth in the new claims 27-45, all of these claims 27-45 are believed to clearly distinguish patentably over Branch et al. '869 under 35 U.S.C. § 103.


Accordingly, this application as amended is now believed to be in condition for allowance with claims 27-45. Accordingly, such action is respectfully solicited.

Applicant hereby requests a one (1) month extension of time. Enclosed please find Check No. 10169 in the amount of \$120.00 in payment of the one (1) month extension of time fee. If it is determined that any additional fees are due with this

submission, the Commissioner is hereby authorized and respectfully requested to charge such fee to our deposit Account No. 50-0852.

Respectfully submitted,

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Enclosures

1. "Patent Claims" 1-26 as amended (now claims 27-45)
in WORD TRACKING software format
2. Check No. 10169 in the amount of \$120.00
3. English Translation of EPO Preliminary Report of Patentability